

Notice of Allowability

Application No.

10/825,921

Examiner

Nashaat T. Nashed, Ph. D.

Applicant(s)

YOUNG, DAVID MICHAEL

Art Unit

1656

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to applicant response on August 24, 2006.
2. ☒ The allowed claim(s) is/are 8.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date 4/15/04
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

Art Unit: 1656

The application has been amended as requested in the communication filed August 24, 2006. Accordingly, new claims 5-7 have been added and claim 3 has been amended.

Applicant's election without traverse of Group II, claim 3, in the reply filed on August 24, 2006 is acknowledged. Claims 1, 2, and 4 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions, there being no allowable generic or linking claim.

Claims 3 and 5-7 are under consideration.

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Frank C. Eisonschenk on November 1, 2006.

The application has been amended as follows:

- (I) Cancel claims 1-7.
- (II) Enter claim 8 as shown below:

Claim 8 A method for identifying thermostable proteases that catalyze the formation of peptide bonds comprising:
 (a) contacting a solution to be assayed for the presence of a thermostable protease with known peptide or polypeptide substrates to form a mixture;
 (b) heating said mixture to a temperature of about 60 degrees C or higher; and
 (c) detecting the formation of a new peptide bond between said substrates;
 wherein said method is performed in the absence of organic co-solvents, product precipitation and activated amino acids.

Claim 8 is allowed.

The following is an examiner's statement of reasons for allowance: The application teaches a thermostable serine protease from *Pyrococcus furiosus*. Said protease has the 20 amino acid residues at the N-terminus of SEQ ID NO: 1. Also, it teaches method of using said protease in making peptides or ligating an amino acid to peptide at temperatures above 60 degrees in the absence of any organic co-solvent,

Art Unit: 1656

wherein the substrates and the newly formed peptide are completely soluble in water. Claims directed to a method of ligating peptides and amino acids were allowed in parent applications serial numbers 09/197,945 and 09/404,031, now U. S. patent 6,143,517 and 6,573,065. Since methods of making peptides and identifying thermostable protease using an assay involving peptide bond formation were restricted, no obviousness double patenting issues could be raised in the instant application. Since the claimed method is novel and non-obvious over the prior art of record. The claim is allowed.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nashaat T. Nashed, Ph. D. whose telephone number is 571-272-0934. The examiner can normally be reached on MTWTF.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathleen M. Kerr can be reached on 571-272-0931. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Nashaat T. Nashed, Ph. D.
Primary Examiner
Art Unit 1656
